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REMARKS

Claims 39-58 are pending in the Application. Claims 51 and 52 have been amended. Claims 1-38 are canceled without prejudice.

Claim Rejections - 35 U.S.C. § 102

The Patent Office rejected claims 51, 52 and 54 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,154,771 by Rangan et al. ("Rangan").

Applicant respectfully traverses. The present application is directed to a system and method for modifying video to provide additional content based upon the content of the video and a stored user profile whereby the modified video may be customized to the user. (Instant Application, Page 10, Lines 17-27). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983). Emphasis added.

Applicant respectfully submits claim 51 includes novel and nonobvious elements which have not been disclosed, taught or suggested by Rangan. For example, claim 51 generally recites retrieving a user profile and dynamically adding interactive content information to the video based upon the profile information. Emphasis added. Rangan fails to disclose, teach or suggest retrieving a user profile and dynamically adding interactive content information to the video based upon the profile information. The Patent Office cites Column 11, lines 16-25 and 47-53 as disclosing user-specific and targeted hyperlinks. However, these passages merely disclose what content a user may acquire by clicking on a hyperlink. This is not equivalent to retrieving a user profile and adding interactive content based upon the user profile as recited in claim 51. Consequently, an element of claim 51 has not

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been disclosed, taught or suggested by Rangan. Under *Lindemann*, a *prima facie* case of anticipation has not been established for claim 51. Claims 52 and 54 are believed allowable due to their dependence upon an allowable base claim.

Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claims 39-44, 46, 50 and 55-57 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,771 by Rangan et al., ("Rangan") in view of U.S. Publication Number 2002/0059629 by Markel et al., ("Markel").

The Patent Office rejected claims 45 and 49 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,771 by Rangan et al., ("Rangan") in view of U.S. Publication Number 2002/0059629 by Markel et al., ("Markel") in further view of U.S. Patent No. 6,637,032 by Feinleib, ("Feinleib").

The Patent Office rejected claims 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,771 by Rangan et al., ("Rangan") in view of U.S. Publication Number 2002/0059629 by Markel et al., ("Markel") in further view of U.S. Patent No. 6,560,777 by Blackletter et al., ("Blackletter").

The Patent Office rejected claim 53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,771 by Rangan et al., ("Rangan").

The Patent Office rejected claim 58 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,771 by Rangan et al., ("Rangan") in view of U.S. Patent No. 6,637,032 by Feinleib, ("Feinleib").

Applicant respectfully traverses each rejection under 35 U.S.C. § 103(a). The present application is directed to a system and method for modifying video to provide additional content based upon the content of the video and a stored user profile whereby the modified video may be customized to the user. (Instant Application, Page 10, Lines 17-27). To establish *prima facie* obviousness of a claimed invention,

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all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Applicant respectfully submits claims 39 and 46 include novel and nonobvious elements which have not been disclosed, taught or suggested by Rangan or Markel, individually or in combination. Claims 39 and 46 generally recite retrieving a user profile and adding content information to the video based upon the profile information. Rangan and Markel fail to disclose, teach or suggest retrieving a user profile and dynamically adding interactive content information to the video based upon the profile information. The Patent Office cites Column 11, lines 16-25 and 47-53 as disclosing user-specific and targeted hyperlinks. However, these passages merely disclose what content a user may acquire by clicking on a hyperlink. This is not equivalent to retrieving a user profile and adding interactive content based upon the user profile as recited in claims 39 and 46.

The Patent Office further cites paragraphs [0010], [0030] and [0034] of Markel for support of its assertion that Markel discloses retrieving user profile information and adding content information to the video based upon the retrieved profile information. However, Markel merely discloses the retrieval of model information for a particular set-top box, whether it is a WebTV implementation or AOLTV implementation. (Markel, Paragraph [0034]). This profile does not relate to the user, rather, the profile relates only to a particular model of a set-top box. Consequently, an element of claims 39 and 46 has not been disclosed, taught or suggested by Rangan or Markel, individually or in combination. Under *in re Ryoka*, a *prima facie* case of obviousness has not been established for claims 39 and 46. Claims 40-45, 47-50, 53 and 55-58 are believed allowable due to their dependence upon an allowable base claim.

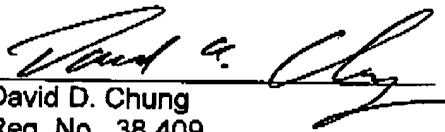
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Conclusion

Applicant respectfully submits that all claims are allowable, and it is respectfully requested that the entire application now be passed to formal allowance.

Respectfully Submitted,

Dated: 31 Jan. 06


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